

REMARKS

The Non-final Office Action mailed July 16, 2008, has been received and reviewed. Claims 1, 12, 15, 24, 27, and 37 stand rejected. Claim(s) 1, 12, 15, 24, 27, and 37 have been amended herein. It is respectfully submitted that no new matter has been added. Reconsideration of the above-identified application in view of the above amendments and the following remarks is respectfully requested.

Rejections based on 35 U.S.C. § 112

Claims 1, 12, 15, 24, 27 and 37 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claims 1, 12, 15, 24, 27 and 37 have been amended herein to correct the antecedent basis issues identified in the Office Action. Regarding independent claims 1 and 27, Applicants have changed “the authorization” to “authorization.” Regarding independent claim 15, Applicants have changed “the authorization” to “authorization,” added an earlier statement of “a set of criteria” to which “the set of criteria” now refers, and deleted “the identification of data.”

Applicants respectfully submit that the amendments overcome the 35 U.S.C. § 112, second paragraph, rejection to independent claims 1, 15, and 27. Dependent claims 12, 24, and 37 depend from independent claims 1, 15, and 27, respectively. As such, Applicants respectfully request withdrawal of the 35 U.S.C. § 112, second paragraph, rejection to claims 1, 12, 15, 24, 27 and 37 .

Rejections based on 35 U.S.C. § 103(a)

Title 35 U.S.C. § 103(a) declares, a patent shall not issue when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” The Supreme Court in *Graham v. John Deere* counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in *Graham* and to provide some reason, suggestion, or motivation found either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the prior art reference or to combine prior art reference teachings to produce the claimed invention. See, *Application of Bergel*, 292 F. 2d 955, 956-957 (1961). Thus, in order “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” See MPEP § 2143. Recently, the Supreme Court elaborated, at pages 13-14 of *KSR*, it will be necessary for [the Office] to look at interrelated teachings of multiple [prior art references]; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by [one of]

ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the [patent application].” *KSR v. Teleflex*, 127 S. Ct. 1727 (2007).

Rejections based on Goel et al., Kirsch, Land et al., and Walters et al.

Claims 1, 15 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goel et al., U.S. Patent No. 7,130,841, in view of Kirsch, U.S. Patent No. 7,031,954, Land et al., U.S. Publication No. 2006/0080306 and Walters et al., U.S. Patent No. 7,216,115. Claims 1, 15, and 27 have been amended to more clearly set forth the claimed subject matter. As the asserted combination of references fails to disclose all of the limitations set forth in the amended claims, Applicants respectfully traverse these rejections as hereinafter set forth.

Amended independent claim 1 sets forth a method for managing data available for access on a computer network, the method comprising obtaining, at a host computing device associated with a user, a first user request to identify data corresponding to a set of criteria on both the host computing device and at least one network computing device and merging the results to generate a first user result. The method further comprises obtaining a second user result identifying data on the host computing device or on a network device and determining that at least one computing device in the network that was previously searched as a result of the first user request is unavailable to identify data corresponding to the second user request. Additionally, the method comprises generating a recalled result portion by recalling the portion of the first user result containing data located on the at least one computing device that is unavailable during the second user request. The method further comprises generating a substituted result by substituting the recalled result portion for results from the second user request of the at least one unavailable computing device, thus allowing the stored first user result

for a currently unavailable network computing device to substitute for the second user request search of that same device. *See* Specification at [0031]. The method further comprises generating a merged result by merging the substituted result and the second user result. Thus, it is as if the currently unavailable network computing device were available at the time the second user request is made.

Neither the Goel reference, the Kirsch reference, the Land reference nor the Walters reference describe, either alone or in combination, all of the steps in the method of claim 1, in particular the steps of “generating a recalled result portion by recalling the portion of the first user result containing data located on the at least one computing device that is unavailable during the second user request” and “generating a substituted result by substituting the recalled result portion for results from the second user request of the at least one unavailable computing device.” The Goel reference describes performing a search for both local and remote electronic content in response to a single user query in which the local result and remote result are amalgamated into a single result and displayed. The Goel reference does not describe conducting a second search or determining that at least one network computing device is unavailable to receive a query. The Goel reference also does not describe generating a recalled result portion by recalling the portion of the first user result containing data located on the at least one computing device that is unavailable during the second user request or generating a substituted result by substituting the recalled result portion for results from the second user request of the at least one unavailable computing device.

The Kirsch reference describes an electronic document retrieval system and method in which each user is assigned a user identification number. Through the use of URLs or pointers, each document to which a particular user has access is associated with that user's user

identification number. The Kirsch reference is cited for describing a unique security ID associated with each user and verifying the authorization of users to access data. The Kirsch reference, however, does not describe conducting a second search or determining that at least one network computing device is unavailable to receive a query. The Kirsch reference also fails to describe generating a recalled result portion by recalling the portion of the first user result containing data located on the at least one computing device that is unavailable during the second user request or generating a substituted result by substituting the recalled result portion for results from the second user request of the at least one unavailable computing device.

The Land reference teaches an automatic query system and method in which a client device determines that a remote computing device is unavailable to receive a query, and, as a result, performs the query on the client device instead. Although the system and method described in the Land reference do identify an unavailable device, the Land reference then describes searching locally if a device is unavailable. The Land reference does not describe recalling a stored first user result from a first user search, conducted while the remote computing device was available, to substitute for the remote device while it is unavailable. The Land reference also does not describe performing a second search.

The Walters reference describes an apparatus and method for simultaneously displaying both record names and the associated files that result from a database search conducted by a user. The method described in the Walters reference does combine the results of prior searches with the same terms or keywords with subsequent search records, but this combination of search records is done to avoid performing a new Boolean search or to supplement the results of a standard Boolean search (col. 4, lines 24-31). Applicants' method substitutes previous search results returned for a particular network computing device for current

search results for the device because the device is currently unavailable and unable to be searched.

Neither the Goel reference, the Kirsch reference, the Land reference, nor the Walters reference teach the method steps disclosed by Applicants and discussed above – generating a recalled result portion by recalling the portion of the first user result containing data located on the at least one computing device that is unavailable during the second user request and generating a substituted result by substituting the recalled result portion for results from the second user request of the at least one unavailable computing device. Because the asserted combination of the Goel, Kirsch, Land, and Walters references fails to disclose all of the limitations set forth in amended independent claim 1, Applicants respectfully traverse this rejection.

Amended independent claim 15 sets forth a method for managing data available for access on a computer network having two or more computing devices, the method comprising obtaining a first user request to identify content that corresponds to a set of criteria, the content being stored on the two or more computing devices, wherein one of the two computing devices is a local device. The method further comprises automatically querying the two or more computing devices to determine locations associated with the user's unique security ID and verifying the authorization of the user to access data from these locations that correspond to the first user request. The method further comprises performing a second user search and obtaining a second user result identifying data stored on one or more available computing devices in the network that corresponds to the search and also matches the user's unique security ID. The method also comprises determining that at least one computing device in the network that was previously searched as a result of the first user request is not available to identify data

corresponding to the second user request. Additionally, the method comprises generating a recalled result portion by recalling the portion of the first user result containing data located on the at least one computing device that is unavailable during the second user request. The method further comprises generating a substituted result by substituting the recalled result portion for results from the second user request of the at least one unavailable computing device, thus allowing the stored first user result to substitute for a search result from a currently unavailable network computing device. See Specification at [0031]. The method further comprises generating a merged result by merging the second user result and the substituted result. Thus, it is as if the currently unavailable network computing device were available at the time the second user request is made.

As discussed in greater detail above, neither the Goel, Kirsch, Land, nor Walters references teaches or suggests the method steps disclosed by Applicants and described above – generating a recalled result portion by recalling the portion of the first user result containing data located on the at least one computing device that is unavailable during the second user request and generating a substituted result by substituting the recalled result portion for results from the second user request of the at least one unavailable computing device. Because the asserted combination of the Goel, Kirsch, Land, and Walters references fails to describe all of the limitations set forth in amended independent claim 15, Applicants respectfully traverse this 35 U.S.C. § 103(a) rejection.

Amended independent claim 27 sets forth a method for managing data available for access on a computer network having a computing device directly associated with a user and at least one remote computing device, the method comprising obtaining, by the computing device associated with the user, a first user request to identify data that corresponds to a set of

criteria, the data being stored on the devices in the computer network. The method further comprises obtaining an identification of locally stored data that matches the first user request criteria that the user is authorized to access according to the user's unique security ID. The method further comprises transmitting the first user request from the computing device associated with the user to the at least one remote network computing device and combining the local and remote results into a first user result. The method further comprises performing a similar second user search and obtaining a second user result. The method also comprises determining that at least one remote computing device in the network that was previously searched as a result of the first user request is not available to identify data corresponding to the second user search. Additionally, the method comprises generating a recalled result portion by recalling, by the computing device directly associated with the user, the portion of the first user result containing data located on the at least one remote computing device that is unavailable during the second user request. The method further comprises generating a substituted result by substituting the recalled result portion for results from the second user request of the at least one unavailable remote computing device, thus allowing the stored first user result to substitute for a search result from a currently unavailable remote network computing device. See Specification at [0031]. The method further comprises generating a merged result by merging the substituted result and the second user result. Thus, it is as if the currently unavailable remote network computing device were available at the time the second user request is made.

As discussed in greater detail above, neither the Goel, Kirsch, Land, nor Walters references teach or suggest the method steps disclosed by Applicants and described above – generating a recalled result portion by recalling, by the computing device directly associated with the user, the portion of the first user result containing data located on the at least one remote

computing device that is unavailable during the second user request and generating a substituted result by substituting the recalled result portion for results from the second user request of the at least one unavailable remote computing device. Because the asserted combination of the Goel, Kirsch, Land, and Walters references fails to describe all of the limitations set forth in amended independent claim 27, Applicants respectfully traverse this 35 U.S.C. § 103(a) rejection.

In summary, because independent claims 1, 15, and 27 each recite method steps not described by any of the cited references, Applicants respectfully traverse these 35 U.S.C. § 103(a) rejections.

Rejections based on Goel et al., Kirsh, Land et al., Walters et al., and Smith

Claims 12, 24 and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Goel, Kirsch, Land, and Walters references, in view of Smith, U.S. Publication No. 2002/0059163. Claims 12, 24, and 37 have been amended to more clearly set forth the claimed subject matter. Claims 12, 24, and 37 depend directly from claims 1, 15, and 27, respectively. Because independent claims 1, 15, and 27 are believed to be in condition for allowance as discussed above, and because the Smith reference does not describe the features of claim, that the Goel, Kirsch, Land, and Walters references fail to describe, Applicants respectfully traverse these rejections and submit that amended claims 12, 24, and 37 are in condition for allowance.

The Smith reference also fails to disclose all of the limitations set forth in the amended independent claims. The Smith reference describes searching information based upon search criteria, wherein search results are displayed and results that are not available may be flagged as unavailable. The Smith reference, however, does not disclose generating a recalled result portion by recalling the portion of the first user result containing data located on the at least one computing device that is unavailable during the second user request and generating a

substituted result by substituting the recalled result portion for results from the second user request of the at least one unavailable computing device.

Neither the Goel, Kirsch, Land, Walters, nor Smith references teach or suggest all elements of the methods of dependent claims 12, 24, and 37. Because the asserted combination of the Goel, Kirsch, Land, Walters, and Smith references fails to describe all of the limitations of dependent claims 12, 24, and 37, Applicants respectfully traverse this 35 U.S.C. § 103(a) rejection.

CONCLUSION

For at least the reasons stated above, claims 1, 12, 15, 24, 27, and 37 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or TWilhelm@shb.com (such communication via email is herein expressly granted) – to resolve the same. The Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

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